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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,155	12/14/1998	MICHAEL EPSTEIN	PHA-23-548	7465

7590 10/24/2002

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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/211,155

Applicant(s)  
Epstein

Examiner  
Paul E. Callahan

Art Unit  
2132



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 22, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11, 13-18, and 20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-18, and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 5-22-02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/211,155 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 1, 3-11, and 12-20 were pending in this application. Claim 19 has been canceled as per the Amendment of 5-22- 2002. Claims 1, 3-11, 13-18, and 20 have been examined.

### ***Response to Arguments***

3. Applicant's arguments filed 5-22-02 have been fully considered but they are not persuasive.

Applicant argues that the Tomko '912 and the Chaum '870 references do not teach the feature found in the Applicant's independent claims of: "The apparatus comprising an authentication encryptor that encrypts a challenge parameter using the decrypted PIN provided by the processor" However, as was noted in the previous Office Action in the case, such is taught in the Chaum reference at col. 12 line 63 through col. 13 line 8, and encrypted response parameter based upon a decrypted security key is taught additionally by Chaum at col. 15 lines 5-50.

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***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-11, 13-17, 18 and 20 were previously rejected under 35 USC 103(a) as being obvious over Tomko US Patent 5,712,912, and Chaum US Patent 4,529,870. Only the language of claims 18 and 20 has been changed by the amendment of 5-22-02. The text of the rejections of these claims as found in the previous Office Action will not herein be repeated, but instead are hereby incorporated in their entirety by reference to the previous Office Action. Accordingly, the Applicant is referred to the previous Office Action in the case for the text of those rejections.

As per claim 18, the amendment of 5-22-02 changes the language of the claim to add the additional limitation of the steps of “enabling” encryption of a security key, “enabling” the determination of a second biometric key, “enabling” decryption of the encrypted security key, enabling the token to receive a challenge parameter, and “enabling” the determination of access status. Such “enabling” is taught inherently by the combination of the Tomko and Chaum references. As was noted in the previous Office Action in the case, the Tomko and Chaum references do indeed teach at the passages cited, the carrying out of these operations, therefore they “enable” these operations to be carried out, or are in the alternative themselves “enabled” to carry out these operations by their configuration and programming. Chaum explicitly teaches the added limitation of enabling the token to receive a challenge parameter in col. 12 line 63

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through col. 13 line 8, and additionally at col. 15 lines 5-50. The remaining limitations in claim 18 are rejected as before as discussed in the previous Office Action.

As per claim 20, the language of the claim has been changed only so as to make it depend from claim 18. The claim remains rejected as before based on the discussion found in the previous Office Action in the case.

***Conclusion***


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239 Official Faxes, X-7240 Unofficial Faxes, X-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

9/30/02

Paul Callahan

  
GILBERTO BARRÓN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100